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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,799	06/20/2001	Ching-Yu Lin	4712-117 US	4493

7590 03/19/2003

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EXAMINER
MYERS, CARLA J

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/885,799	LIN ET AL.	
	Examiner	Art Unit	
	Carla Myers	1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet.*

3. ☒ Applicant's reply has overcome the following rejection(s): *See Continuation Sheet.*

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet.*

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-3,5 and 13-19.*

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Carla Myers
CARLA J. MYERS
PRIMARY EXAMINER

Continuation of 2. NOTE: Newly added claim 20 raises new issues that would require further search and examination because the claim requires that the second oligonucleotide is selected from a group of oligonucleotides that is different than the group of oligonucleotides from which the first oligonucleotide is selected, whereas the currently pending claims do not include specific groups of oligonucleotides and do not require the selection of the oligonucleotides from 2 different groups. In addition, the claim raises new issues under 112 second paragraph because the claim is indefinite in that it recites that the oligonucleotide "is selected" from a group. The claims do not recite a specific step of selecting oligonucleotides and it is unclear as to how this recitation is intended to further limit the claims- i.e., do the claims include a mental step or an active step of selecting oligonucleotides or is it a property of the oligonucleotides that they belong to different groups?

Continuation of 3. Applicant's reply has overcome the following rejection(s): the new matter rejections set forth in paragraphs 11 and 12 of the previous office action.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons of record in view of the non-entry of the after final amendment. In addition, Applicants response states that the claims are drawn to a detector and that none of the claims are drawn to oligonucleotides. It is asserted that the "Markush group of oligonucleotides are merely reagents for employment in the claimed device." This statement is unclear. Does this mean that the oligonucleotides are irrelevant and that the examiner should disregard these limitations in the claims? Are the claims intended to be limited to devices which comprise a carrier and any oligonucleotide, such that a reference teaching any solid support with an oligonucleotide attached would anticipate the claims? As currently written, the claims recite devices comprising a carrier and a first oligonucleotide and a second oligonucleotide. The claims require the limitations of specific oliognucleotides having specific sequences. It is unclear as to how applicants can on the one hand argue that the oligonucleotides are unobvious and yet state that the claims are not limited to oligonucleotides and that the oligonucleotides are only reagents to be used in the claimed device. If the claims are intended to be limited in such a manner, then the claims should not recite that the device comprises the oligonucleotides-the claims should recite that the device comprises only the carrier. Applicants state that the examiner appears to construe the claims incorrectly and that the claims are drawn to devices that employ at least 2 of the recited oligonucleotides. However, "at least 2" includes 2 and thus the restriction required the election of 2 of the oligonucleotides from the recited list of sequences. Additionally, the claims are not drawn to devices which "employ" oligonucleotides, but to devices which comprise oligonucleotides. Further, claim 13 is drawn to a method for detecting HPV wherein the method comprises providing at least one oligonucleotide. Are applicants also asserting that the claims to methods do not require the search of the stated oligonucleotides? Applicants arguments concerning the 103 rejection are not persuasive. Applicants have not pointed out why the resultant combination would not be obvious. The office action sets forth the teachings in the art and the guidance and motivation in the art to generate additional HPV probes. Applicants state generically that there is no reasonable expectation of success, but do not clarify how this comment pertains to the instant rejection.